UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,998	06/14/2006	Sang Yong Bae	56587.22	1534

27128   7590   05/28/2009
HUSCH BLACKWELL SANDERS LLP
720 OLIVE STREET
SUITE 2400
ST. LOUIS, MO 63101

EXAMINER
UBER, NATHAN C

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
05/28/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto-sl@huschblackwell.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _25 February 2009_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-16 and 18_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-16 and 18_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This action is in reply to the amendment filed on 25 February 2009.

2.   Claims 1, 12 and 18 have been amended.

3.   Claims 1-16 and 18 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

4.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.   Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 February 2009 has been entered.

Claim Rejections - 35 USC § 112

5.   The previous 112 2nd rejection of claim 18 is withdrawn.

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7.   Claims 4, 5 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant added the limitation *the expansion keyword is in genus-species hierarchies with the keyword* to claims 4, 5 and 16. Applicant argues that ¶0100 of the specification and figure 13 provides support for this new limitation. Examiner disagrees, neither the cited paragraph nor

figure 13 disclose or illustrate a genus-species hierarchy relationship among keywords. Since Applicant's original disclosure does not teach a genus-species hierarchy among keywords, the limitation is considered new matter and the claims are therefore rejected under U.S.C. § 112 first paragraph. Applicant further argues that "Examiner also states that the tern 'expansion keyword' is known and understood in the art" then Applicant continues to argue/declare that the term is well known in the art (see page 14 of Applicant's response). Examiner made no such representation; further whether the term is known in the art is not relevant to the current rejection. The claims are rejected because the subject matter is new matter; the term was not part of the original disclosure and therefore cannot be claimed. Whether subject matter is known in the art does not answer the question of whether the subject matter was in the possession of the inventors at the time of invention. This rejection is maintained.

8.   Claims 1-5 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant amended the claims to overcome a U.S.C. 101 rejection by adding two structural limitations so that the claims no longer lacked structural features. The new limitations *a processor* and *one or more memories* are not supported by the original specification. Therefore these new limitations are considered new matter and claims 1-5 and 12 are rejected under U.S.C. § 112. Applicant argues that "it is impossible to implement an online system" without the claimed processor and memories therefore the structural features are inherent to Applicant's disclosure. This argument however is not relevant to the current rejection. Examiner originally interpreted claims 1-5 and 12 to be directed to software and not structural features. It is possible to implement Applicant's invention as purely software. The new features of a processor and memory were not part of the original disclosure, the features are new matter and therefore they cannot be claimed. The rejection is maintained with regard to claims 1-5 and presented for the first time with regard to claim 12.

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is directed to a system; however Applicant added the limitation *determining a content category...* to the claim. The determining step is not a structural feature nor is it tied to a structural feature of the claim. The claim is therefore indefinite because it is not clear whether the claim is actually directed to a system.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

13.   **Examiner's Note**: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or

part of the claimed invention, as well as the context of the passage as taught by the prior art or

disclosed by the Examiner.

14.   Claims 1-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean et al.

(U.S. 2004/0059708 A1) in view of Anick et al. (U.S. 6,778,975 B1).

15.   Claims 1-7, 9, 12-13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by.

Claim 1:

Dean, as shown, discloses the following limitations:

- *a processor* (see at least figure 3, item 308),

- *one or more memories to communicate with the processor, the one or more*

  memories storing database (see at least figure 3, item 309),

- *an advertisement database for maintaining advertisement data of a plurality*

  of advertisements, at least one keyword related to each said advertisement

  and a category corresponding to each said advertisement (see at least

  Figure 2, Item 240; see also at least ¶0027 data stored in ad database

  includes keyword and ad),

- *an advertisement data searching unit configured for searching the*

  advertisement database for advertisement data corresponding to the

  maintained category related to the content to be displayed to a user (see at

  least Figure 2, Item 260; see also at least ¶0032-0033 selection component

  receives request for ads and performs the search and provides the result to

  the ad ordering component),

- *an advertisement data selecting unit configured for selecting a portion of*

  advertisement data among the searched advertisement data, based on a

  predetermined criterion, by using a keyword related to the searched

  advertisement data (see at least Figure 2, Item 260; see also at least ¶0032-

  0033 selection component receives request for ads and performs the search

  and provides the result to the ad ordering component),

- *a display control unit configured for controlling an advertisement associated with the selected advertisement data to be displayed on the user terminal in association with the content* (see at least Figure 2, Item 280; see also at least ¶0034, prepares ad for presentation to the user),

- *determining a content category for content provided to a user terminal through a communication network via a content classifying system utilizing a predetermined classification algorithm, a content category for classifying and content according to relevant advertising* (see at least ¶0047-0050, topics of content are determined by analysis of the text in the content and one of several of different possible predetermined algorithms applied to the analysis; ¶0047 discloses determining the relative number of times a word appears; ¶0049 discloses weighting; ¶0050 discloses scoring; Examiner notes that this limitation is interpreted with the broadest reasonable interpretation in light of the specification and further notes that page 7, lines 5-9 and page 14, lines 22-24 Applicant discloses that the content classification system determines the classification of content from the text and in step 992 using keywords from the content text),

Dean discloses multiple databases (see at least figure 2, item 240). Dean does not specifically disclose a database that stores the particular data in the following limitation. However, Anick, as shown discloses the following limitation:

- *a content database for maintaining at least a content identifier and at least a predetermined content category associated with a said content identifier, where a content identifier for identifying content provided to a user terminal though a communication network, and where a content category for said content determined via a content classifying system, a said content category for classifying said content according to relevant advertising* (see at least

column 5, lines 9-20, web directory storing documents, document identifiers/references and categories for each document),

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the advertisement selecting methods of Dean, including categorizing web content, with the advertisement selecting methods of Anick which stores web document classification in an indexed database (rather than reclassifying documents for every search as in Dean) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable and because Anick discloses that the web directory is optimized to allow fast retrieval of references (see column 5, lines15-17).

Claim 2:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitations:

- *the advertisement data selecting unit comprises a keyword searching module, resident in one of the memories and executable by the processor, configured for searching the content to be displayed to the user for the at least one keyword related to the searched advertisement data* (see at least ¶0044, analyzing the target document, see also ¶0043 the targeting information may be a keyword, see also ¶0042 the operations described in ¶¶0043+ describe the function that occurs in the ad selection unit Figure 2, Item 260),

- *an exposure point computing module, resident in one of the memories and executable by the processor, configured for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of*

the searched keyword in the content and a font style of the searched keywords (see at least ¶0048, greater frequency of targeted terms),

- *an advertisement data selecting module, resident in one of the memories and executable by the processor, configured for selecting a portion of advertisement data among the searched advertisement data, based on the exposure point* (see at least ¶0033, ads received from the ad selection unit are ordered by relevance based "on a value indication associated with each ad").

Claim 7:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitation:

- *the advertisement data selecting module selects the predetermined number of advertisement data of which the exposure point ranks high* (see at least ¶0033, a list of ads are received from the ad selection unit and are ordered by relevance based "on a value indication associated with each ad").

Claim 9:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitation:

- *the advertisement data selecting module sequentially selects a predetermined number of the selected advertisement data during the predetermined period* (see at least ¶0033, a list of ads are received from the ad selection unit and are ordered by relevance based "on a value indication associated with each ad", here Examiner broadly interprets *predetermined period* based on the specification to mean an arbitrary amount of time including at least the amount processing time required to complete the method).

Claim 3:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitations:

- *keyword database for maintaining a keyword and a similar keyword related thereto, wherein the similar keyword is a keyword having a similar meaning to the meaning of the keyword* (see at least Figure 2, Item 240),

- *wherein the advertisement data selecting unit comprises a keyword searching module, resident in one of the memories and executable by the processor, configured for searching the content for at least one keyword related to the searched advertisement data and a similar keyword to the at least one keyword* (see at least ¶0043 the targeting information may be a keyword. Examiner notes that this claim is directed only to a module, the intended use of the module does not carry any patentable weight. Nevertheless ¶0043 discloses the intended use of the claimed module),

- *an exposure point computing module, resident in one of the memories and executable by the processor, configured for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *an advertisement data selecting module, resident in one of the memories and executable by the processor, configured for selecting a portion of advertisement data from the searched advertisement data, based on the exposure point* (see at least ¶0033, ads received from the ad selection unit are ordered by relevance based "on a value indication associated with each ad").

Claim 4:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitations:

- *a keyword database for maintaining a keyword and an expansion keyword related thereto, wherein the expansion keyword and the keyword are in genus-species hierarchies* (see at least Figure 2, Item 240),

- *wherein the advertisement data selecting unit comprises a keyword searching module resident in one of the memories and executable by the processor, configured for searching the content for a keyword related to the searched advertisement data and an expansion keyword related to the keyword* (see at least ¶0043 the targeting information may be a keyword. Examiner notes that this claim is directed only to a module, the intended use of the module does not carry any patentable weight. Nevertheless ¶0043 discloses the intended use of the claimed module),

- *an exposure point computing module, resident in one of the memories and executable by the processor, configured for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *an advertisement data selecting module, resident in one of the memories and executable by the processor, configured for selecting a portion of advertisement data from the searched advertisement data, based on the exposure point* (see at least ¶0033, ads received from the ad selection unit are ordered by relevance based "on a value indication associated with each ad").

Claim 5:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitations:

- *keyword database for maintaining a keyword, a similar keyword related thereto and an expansion keyword related thereto, wherein the similar keyword is a keyword having a similar meaning to the meaning of the keyword and the expansion keyword is in genus-species hierarchies with the keyword (see at least Figure 2, Item 240),*

- *wherein the advertisement data selecting unit comprises a keyword searching module, resident in one of the memories and executable by the processor, configured for searching the content for a keyword related to the searched advertisement data, a similar keyword related to the keyword and an expansion keyword related thereto keyword (see at least ¶0043 the targeting information may be a keyword),*

- *an exposure point computing module, resident in one of the memories and executable by the processor, configured for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords (see at least ¶0048, greater frequency of targeted terms),*

- *for computing a second exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords (see at least ¶0048, greater frequency of targeted terms),*

- *for computing a third exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content*

and a font style of the searched keywords (see at least ¶0048, greater

frequency of targeted terms),

- *computing an exposure point based on at least one of the first exposure*

  point, the second exposure point and the third exposure point (see at least

  ¶0048, documents with greater frequency of targeted terms get greater

  weight),

- *an advertisement data selecting module, resident in one of the memories and*

  executable by the processor, configured for selecting a portion of

  advertisement data from the searched advertisement data, based on the

  exposure point (see at least ¶0033, ads received from the ad selection unit

  are ordered by relevance based "on a value indication associated with each

  ad"),

With regard to analyzing advertisements multiple times and calculating multiple *exposure*

points, Dean discloses "additionally or alternatively" analyzing multiple words in one

document (see at least ¶0048) as well as analyzing meta data (see at least ¶0051).

Claim 6:

The combination Dean/Anick discloses the limitations as shown in the rejection above.

Further Dean, as shown, discloses the following limitation:

- *the exposure point computing module computes the exposure point by*

  applying a weight value to the first exposure point, the second exposure point

  or the third exposure point (see at least ¶0051, different value

  measures/weights may be used "alternatively or in addition" to each other).

Claims 8 and 10-11:

The combination Dean/Anick discloses the limitations as shown in the rejection above.

Further Dean, as shown, discloses the following limitations:

- *the advertisement data selecting module selects predetermined*

  advertisement data from the searched advertisement data on the basis of the

> *exposure point and* (see at least ¶0033, a list of ads are received from the ad
> selection unit and are ordered by relevance based "on a value indication
> associated with each ad"),

- *selects a predetermined number of random advertisement data, during a predetermined period, from the selected advertisement data* (see at least ¶0033, a list of ads are received from the ad selection unit and "may be ordered based on the value indication")

Dean does not specifically disclose that the ordering may be random. However, there are only a finite number of ways to order a predetermined list of advertisements for presentation to a user (including in order of relevancy, based on the rate paid for the ad, randomly, etc.) Further Anick discloses selecting categories randomly (dart-board) when more than one category includes documents that match a search (see at least column 6, lines 1-20). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to try a different criteria for ordering the advertisements for presentation to the user (such as random ordering/selection) since there are a finite number of identified, predictable potential solutions and one having ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

Claims 12 and 18:

Dean, as shown, discloses the following limitations:

- *maintaining advertisement data, at least one keyword related to the advertisement data and a category corresponding to the advertisement data, in an advertisement database* (see at least ¶0030, ad data stored in databases),

- *determining a content category for content provided to a user terminal through a communication network via a content classifying system utilizing a predetermined classification algorithm, a content category for classifying and*

content according to relevant advertising see at least ¶0047-0050, topics of content are determined by analysis of the text in the content and one of several of different possible predetermined algorithms applied to the analysis; ¶0047 discloses determining the relative number of times a word appears; ¶0049 discloses weighting; ¶0050 discloses scoring; Examiner notes that this limitation is interpreted with the broadest reasonable interpretation in light of the specification and further notes that page 7, lines 5-9 and page 14, lines 22-24 Applicant discloses that the content classification system determines the classification of content from the text and in step 992 using keywords from the content text),

- *storing at least one of said databases in a memory* (see at least ¶0038, databases are stored in secondary storage element to the main memory of the server device)m,

- *searching the advertisement database for advertisement data corresponding to the category related to the content to be displayed to a user* (see at least ¶0032, ad selection component),

- *selecting advertisement data among the searched advertisement data, based on a predetermined criterion, by using at least one keyword related to the searched advertisement data* (see at least ¶0033, ad ordering component),

- *controlling an advertisement associated with the selected advertisement data to be displayed on the user terminal in association with the content,* (see at least ¶0034, ad serving component)

- *where said steps of determining a content category, searching the advertisement database, selecting advertisement data and controlling an advertisement is preformed by a processor* (see at least ¶0036, processors executes the program stored in the memory; see also at least ¶0040 the

memory stores the programs depicted in figure 2 and described in ¶¶0032-0035),

Dean discloses multiple databases (see at least figure 2, item 240). Dean does not specifically disclose a database that stores the particular data in the following limitation. However, Anick, as shown discloses the following limitation:

- *maintaining a content database in which at least identifier and at least a said content category associated with a said content identifier are stored, for identifying content provided to a user terminal through a communication network* (see at least column 5, lines 9-20, web directory storing documents, document identifiers/references and categories for each document),

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the advertisement selecting methods of Dean, including categorizing web content, with the advertisement selecting methods of Anick which stores web document classification in an indexed database (rather than reclassifying documents for every search as in Dean) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable and because Anick discloses that the web directory is optimized to allow fast retrieval of references (see column 5, lines15-17).

Claim 13:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitations:

- *maintaining the advertisement database comprises the steps of: receiving a keyword and advertisement data from an advertiser* (see at least ¶0027, ad entry management component),

- *receiving selection of a category for the advertisement data from the advertiser* (see at least ¶0027, ad entry management component),
- *storing the received keyword and the category in association with the advertisement database* (see at least ¶0030, ad data stored in databases).

Claim 14:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean discloses determining relevant advertisement and content topics; however Dean does not specifically disclose categories as in the limitations below. Anick, as shown, discloses the following limitations:

- *receiving selection of a category from the advertiser comprises the steps of maintaining categories in a predetermined database* (see at least column 6, lines 54-55, advertisers specify categories for their ad submissions),
- *providing the categories for the advertiser by a directory searching method* (see at least column 5, line 17-27, the categories are predetermined),
- receiving selection of a predetermined category among the provided categories, from the advertiser (see at least column 6, lines 54-55, advertisers specify categories for their ad submissions),

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine with Dean the additional functionality of Anick which allows advertisers to additionally categorize their ads rather than rely solely on keywords to determine advertising relevancy to content since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 15:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitations:

- *maintaining keywords in a keyword database* (see at least ¶0030, ad data stored in databases),

- *wherein the step of selecting advertisement data according to a predetermined criterion from the searched advertisement data by using the keyword comprises the steps of respectively searching the content for a keyword related to the advertisement data* (see at least ¶0043, identifying documents by keyword),

- *for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *selecting advertisement data from the searched advertisement data based on the exposure point* (see at least ¶0033, ad ordering component).

Claim 16:

The combination Dean/Anick discloses the limitations as shown in the rejection above. Further Dean, as shown, discloses the following limitations:

- *maintaining a keyword, a similar keyword related thereto or an expansion keyword related thereto in a keyword database, wherein the similar keyword is a keyword having a similar meaning to the meaning of the keyword and the expansion keyword is in genus-species hierarchies with the keyword* (see at least ¶0030, ad data stored in databases),

- *wherein the step of selecting advertisement data according to a predetermined criterion from the searched advertisement data using the keyword comprises the steps of respectively searching the content for a keyword related to the advertisement data* (see at least ¶0043 the targeting information may be a keyword),

- *searching for a similar keyword related to the searched keyword or an expansion keyword related thereto* (see at least ¶0043, using keywords and similar keywords),

- *computing a first exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *computing a second exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *computing an exposure point from the searched advertisement data, based on the first exposure point or the second exposure point* (see at least ¶0048, documents with greater frequency of targeted terms get greater weight).

Response to Arguments

16.   Applicant's arguments with respect to claims 1, 12 and 18 have been considered but are moot in view of the new grounds of rejection.

17.   Applicant's arguments attempt to distinguish the Dean reference from Applicant's invention on the basis that Dean's determination of "topics" is different from Applicant's determination of "categories." Specifically Applicant writes that Dean uses text and keywords from the web content itself to determine the topic of the web content and that use of such words is likely to produce incorrect determinations. Applicant proffers an example in which a crime report that mentions a refrigerator under the Dean method may result in an incorrect determination that the topic of the web content is related to refrigerators and inappropriately call up a refrigerator advertisement.

Whereas Applicant argues that the *classification system* of Applicant's invention would classify the same document in a category unrelated to refrigerators or electronics (see pages 16 and 17 of Applicant's remarks). Examiner appreciates Applicant's explanation and understands the distinction Applicant is attempting to make. However, Examiner is not convinced that the distinction Applicant describes in Applicant's arguments is actually claimed in the claims. As noted in the rejection above, Applicant claims determining the classification of content broadly indicating only that classification occurs via *content classifying system* that utilizes a predetermined algorithm. Applicant's original disclosure supports the *content classification system* utilizing a predetermined algorithm but does not elaborate on what algorithm is used. Dean also discloses using algorithms to determine the topic (see at least ¶0047-0050), thus it is not clear from the claims nor from Applicant's supporting disclosure that the algorithm in Applicant's claims is patentably distinct from the algorithms of Dean. Further as noted above, Applicant discloses that the content classification system determines the classification of content from the text of the content (see page 7, lines 5-9 of the specification) and that the content classification system uses keywords from within the text of the content to categorize the content (see page 14, lines 22-24 of the specification). Therefore Examiner is forced to interpret Applicant's "determining content category" limitation to be the same as the "topic determining" feature of Dean, which uses at least the text of the document and a predetermined algorithm to determine the topic of the web content.

18.   Applicant's argument that Dean does not disclose storing categories in a database in association with content identifiers (see pages 17 and 18 of Applicant's remarks) was persuasive. Applicant's claim amendments to claim this aspect of Applicant's invention are addressed by the new ground of rejection above.

Conclusion

19.   Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923.** The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.

20.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

21.   Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

22.   Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
20 May 2009

/Arthur Duran/
Primary Examiner, Art Unit 3622